

Group II: Claims 53-57, drawn to a method of caring for or making up the lips or skin and/or preserving its gloss and/or making the film comfortable to wear.

Applicants elect, with traverse, Claims 1-52, drawn to a composition comprising a non-volatile hydrocarbon based oil, a non-volatile silicone compound, an inert particulate phase and a dispersant, for further prosecution.

In regard to Groups I and II, the Office has characterized the relationship between these two groups as product and process of use. Citing MPEP §806.05(h), the Office concludes that the process “of caring for or making up the lips or skin and/or preserving its gloss and/or making the film comfortable to wear” can be practiced “by a composition consisting of petroleum jelly”. However, the Office has not provided reasons and/or examples to support this conclusion. Further, the Office has failed to show that “the composition consisting of petroleum jelly” proposed is materially different from the claimed composition. Accordingly, the Office has merely put forth a conclusion lacking any evidence whatsoever. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Applicants further traverse the Restriction Requirement on the additional ground that a search of all the claims would not impose a serious burden on the Office. The MPEP in §803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office and the Restriction Requirement. Applicants respectfully submit that the Restriction Requirement is unsustainable; and therefore, it should be withdrawn.

In addition, the Office has issued an Election of Species Requirement. More specifically, the Office is requiring Applicants “to elect a single discloses speciesa, one specific dispersant and one specific non-volatile hydrocarbon based oil.

Applicants elect, with traverse, poly(hydroxy-12)stearic acid as one specific dispersant and octyldocecy1 neopentanoate as a specific non-volatile hydrocarbon.

Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants’ election of species is for examination purposes only.

Applicants respectfully submit that the Office has not shown that a serious burden exists in searching the entire application.

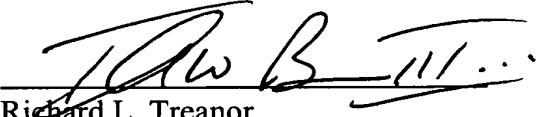
Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Election of Species Requirement. Withdrawal of the Election of Species Requirement is respectfully requested.

Applicants further submit that this application is in condition for examination on the merits and an early notification to that effect is earnestly solicited.

Respectfully submitted,

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